

REMARKS

1. Specification

Appropriate titles have been inserted into the Specification on pages 8 and 9.

2. Claim Rejections – 35 USC § 101

Claim 17 has been canceled, thus rendering this rejection moot.

3. Claim Rejections – 35 USC § 112

3.1 Rejections Under 35 USC § 112, 2nd Paragraph – Indefiniteness

Claims 1-10 have been rejected under 35 USC 112, 2nd paragraph, for alleged indefiniteness. These rejections are respectfully traversed. Reconsideration and withdrawal thereof are requested.

The claims have been amended to be in a format more consistent with standard U.S. claim practice. It is believed that these amendments obviate all of the objections raised by the Examiner. Attached as Appendix 1 for the Examiner's convenience is a "clean" set of the claims.

While claim 8 has been amended, some comments are also relevant to the Examiner's rejection of that claim. The Examiner alleges that it is not clear if the "alcohol" in the Markush selection of claim 8 is the same alcohol as in the Markush selection of claim 1. Applicants submit that the claims are indeed clear and definite when understood by one skilled in the art. Claim 1, in part, defines the "non-peptide compound" as comprising "at least one functional group", which can in fact be an alcohol group. Claim 8, on the other hand, recites that the non-peptide compound itself is a lipid, sugar, an alcohol or a florescent marker. One skilled in the art would obviously understand that an alcohol is a compound having one OH group. On the other hand, according to claim 1 the non-peptide compound can bear one or more alcohol groups,

thereby encompassing not only generically alcohol compounds (such as methanol or ethanol), but also other types of compounds (such as glycols if the compound contains two OH groups).

In essence, while claim 1 is generic to different types of compounds that can contain at least one alcohol group, claim 8 specifically recites an alcohol as one of the specific non-peptide compounds.

Applicants submit that this understanding would be well understood by one skilled in the art, so that the claims are completely proper under 35 USC 112.

In view of the above, reconsideration and withdrawal of the rejections are requested.

3.2 Objections Under 35 USC § 112, 1st Paragraph – Written Description

Claims 1-9 had been rejected under 35 USC § 112, 1st paragraph, as allegedly failing to comply with the written description requirement. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Applicants submit that the Examiner's reasoning with respect to the written description requirement is misplaced and misapplies the case law and Examiner Guidelines with respect to written description.

The only basis for the Examiner's objection appears to be with respect to the term in the claim relating to "compound A of a non-peptidic nature" which contains at least one functional group selected from the group consisting of a carboxylic acid group and an alcohol group. Applicants submit that the Specification as filed clearly evidences that the inventor(s) had possession of the invention as of the filing date with respect to this aspect of the claims.

First of all, any analysis must begin from the principle that the description as filed is presumed to be adequate and the Examiner has the initial burden of presenting evidence or reasoning to explain why a person skilled in the art would not recognize, in the disclosure, a

description of the invention as defined by the claims. See MPEP § 2163.04. Indeed, “there is a strong presumption that an adequate written description of the claimed invention is present when the application is filed.” See, Written description guidelines, Federal Register, Vol. 66, 1099, 1105 (January 5, 2001). Thus, in the present case, the Examiner must begin with the strong presumption that the claims as originally filed comply with the written description requirement.

Indeed, all that is necessary to satisfy the written description requirement is that the specification convey to one skilled in the art that the Applicants were in possession of the claimed invention at the time of filing. See *S. E. Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). The Examiner seems to focus on whether there are a sufficient number of examples within the scope of the term “compound A of a non-peptidic nature”. However, compliance with the written description requirement does not require any working examples. Even [t]he absence of a working example, denominated as such, does not compel the conclusion that a Specification does not satisfy the requirements of 35 USC § 112.” *In re long*, 368 F.2d 892, 895 (CCPA 1966).

In the present case, Applicants have clearly described compound A as a “non-peptidic nature, bearing a function selected from the group consisted by” a carboxylic acid group and an alcohol group. While this term may be broad, Applicants submit that its meaning would be well understood by one skilled in the art, and the Examiner does not even attempt to explain how one skilled in the art would not understand the meaning of the terms.

In addition, the application provides specific description of groups of compounds within the scope of this term, such as lipids, sugars, alcohols and fluorescent markers, and provides specific examples. See for example page 6, lines 19-31. These terms, also, are well understood by those skilled in the art. See, for example, the attached pages from the “McGraw Hill Dictionary of Scientific and Technical Terms”. Since these terms are well understood by those skilled in the art, use of the terms, even without drawings of specific structures, would convey to those skilled in the art that the present inventors “had possession” of the invention as now claimed as of the filing of the application.

Again, the Examiner is reminded that “rejection of an original claim for lack of written description should be rare”. See MPEP § 2163 – Guideline for the Examination of Patent Applications Under 35 USC § 112, paragraph 1 (emphasis added). Applicants submit that the present application is in no way a “rare” type of case where the Examiner should find that the original filed Specification fails to provide sufficient written description support for the original presented claims.

In view of the above, reconsideration and withdrawal of the rejection are requested.

4. Claim Rejections – 35 USC § 102

Claims 1-10 have been rejected under 35 USC § 102(a) as anticipated by Bonnet (Tetrahedron letters, January 200, pages 45-48). This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

As the Examiner notes, the present application claims priority to two French priority applications that were filed prior to the publication date of the cited Bonnet reference. Applicants have already properly submitted a certified copy of each of the priority cases during the PCT International phase. In order to complete the claim to priority and to antedate the prior art reference, enclosed is a sworn English translation of each of the French priority applications. Applicants submit that this action removes the Bonnet reference as citable prior art, so that the rejection should be withdrawn.

In view of the above, Applicants submit that the claims properly define a patentable invention and should, therefore, be allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Leonard R. Svensson Reg. No. 30,330 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

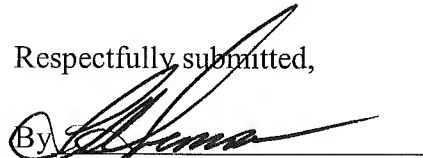
Application No. 10/049,955
Amendment dated August 2, 2007
Reply to Office Action of May 3, 2007

Docket No.: 1217-0156P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: August 2, 2007

Respectfully submitted,

By 

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